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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,275	07/11/2003	Ronald Paul Dean	10017961-2	4838

7590 07/24/2007
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

LE, TAN

ART UNIT PAPER NUMBER

3632

MAIL DATE DELIVERY MODE

07/24/2007

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/618,275
Filing Date: July 11, 2003
Appellant(s): DEAN ET AL.

MAILED

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GROUP 3600

R. Ross Viguet
For Appellant

EXAMINER'S ANSWER

This is in response to the Reply Brief filed June 30, 2006, which is in furtherance of the amended Appeal Brief filed February 9, 2006 appealing from the Office action mailed July 29, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. Note that in the brief, Appellants include a statement that separately argued claims do not stand or fall together and proposes submitting a terminal disclaimer in compliance with 37 C.F.R. 1.321© if the obviousness-type double patenting rejection of claims 1-9, 12-16, 21 and 24 over claims 1-17 of United States patent number 6,666,414 stands upon indication that the claims are allowable.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US 5,823,495	Joss et al.	10-1998
US 5,344,032	Ramsdell	09-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7, 10-16 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Joss et al. (US 5,823,495).

Claims 1-4, 6-9, 12, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ramsdell (US 5,344,032).

(10) Response to Argument

In the following, the examiner responds to appellant's arguments presented in the Reply Brief filed June 30, 2006, which is basically a summary of arguments presented in an amended Appeal Brief filed February 9, 2006. This response, which has been either addressed or not addressed in the final action mailed 7/29/05.

A) Whether appellant's claims 1-7, 10-16 and 21-23 are anticipated under 35 USC 102 by Joss et al.?

As to claim 1, Joss et al. teaches a mounting bracket for a device comprising: a deforming element (a member or part of element 118, 120, which functions as a spring, acts to further dampen vibration, mechanical shocks etc. (Col. 2, lines 61-62)) configured from a resiliently-deformable surface (104), wherein said deforming element can increase a deformability of said resiliently-deformable surface under stress condition; and a pair of attachment members (107) disposed on opposite sides of and attached to said surface and adapted to interface with the device upon deformation of said deforming element.

As to claim 2, said each of said attachment members comprises fastener attachment sites (112, 115) for receiving fasteners for interfacing said attachment members with the device upon deformation of said deforming element.

As to claim 3, said deforming element comprises one or more compression elements (such as compression element of part or member of 120 or 122).

As to claim 4, said deforming element comprises a substantially serpentine metal strip (could be either 104 or 118)

As to claim 5, said deforming element comprises a portion of said surface adapted to provide a spring element.

As to claim 6, said deforming element is adapted to provide linear deformation of said surface (104)

As to claim 7, said deforming element of said surface is compressed to bring said attachment members into contact with said device.

As to claims 10-11, Joss et al. further teaches a thermal interface material disposed between the attachment member and the device and the thermal interface material is a thermally-conductive elastomer sheet material (114, 115) (Col. 2, lines 5-54)

As to claim 12, the device is not a positive part of the claim; therefore this claim limitation is met by Joss et al.

As to claim 13, further comprises screw holes (112) defined in said attachment members.

As to claim 14, said resiliently-deformable surface is deformed by action of screws inserted through said screw holes into said device.

As to claim 15, said resiliently-deformable surface (104) comprises a compressible lateral midline portion connecting opposing outer lateral portions of said surface (105, 108, 109 for example).

As to claim 16, said resiliently-deformable surface includes a flat spring midline portion connecting opposing outer lateral portions of said surface (118, 120).

As to claim 21, Joss et al. teaches the device comprising: a mounting bracket constructed from a thermal conductor (metal)', sidewalls on said mounting bracket constructed from said thermal conductor (metal); and fastening receptacles (112, 115) within said sidewalls for securing said device, wherein said fastening can allow heat to move or flow from one body to another, thus it inherently creates a thermal interface between said device and said sidewalls.

As to claims 22-23, Joss et al. also teaches a thermal interface material (114) disposed between the attachment member and the device and the thermal interface material is a thermally-conductive elastomer sheet material (114) (Col. 2, lines 5-54).

In view of the rejection above, the examiner respectfully submits that all the limitations of claims 1-7, 10-16 and 21-23 are found in the reference of Joss et al., are therefore fully met by Joss et al.

B) Whether appellant's claims 1-4, 6-9, 12, 21 and 24 are anticipated under 35 USC 102 by Ramsdell?

As to claim 1, Ramsdell teaches a mounting bracket for a device comprising:

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a deforming element (a member or part of element 18) (Fig. 2) configured from a resiliently-deformable surface (19) wherein said deforming element increases a deformability of said resiliently-deformable surface under stress condition; and a pair of attachment members (20) (U-shaped) disposed on opposite sides of and attached to said surface and adapted to interface with the device (gun) upon deformation of said deforming element.

As to claim 2, said each of said attachment members (20) comprises fastener attachment sites (grooves 26) for receiving fasteners (25) for interfacing said attachment members with the device upon deformation of said deforming element.

As to claim 3, said deforming element comprise one or more compression elements (members or parts of U-shaped element 18).

As to claim 4, said deforming element comprises a substantially serpentine metal strip.

As to claim 6, said deforming element is adapted to provide linear deformation of said surface.

As to claim 7, said deforming element of said surface is compressed to bring said attachment members into contact with said device.

As to claim 8, said deforming element is comprised of machined aluminum alloy (col. 2, lines 7-8)

As to claim 9, the examiner withdraws claim since claim 9 fails to read on Ramsdell.

As to claim 12, the device is not a positive part of the claim; therefore this claim limitation is met by Ramsdell.

As to claim 21, Ramsdell teaches the device comprising: a mounting bracket (18) constructed from a thermal conductor', sidewalls on said mounting bracket constructed from said thermal conductor; and fastening receptacles (20) within said sidewalls for securing said device, wherein said fastening creates a thermal interface between said device and said sidewalls.

As to claim 24, said thermal conductor comprises aluminum alloy (see col. 2, lines 7-8).

In view of the rejection above the examiner also respectfully submits that all the limitations of claims 1-4, 6-8, 12, 21 and 24 are found in the reference of Ramsdell, are therefore fully met by Ramsdell.

In response to Applicant's argument on the Reply Brief filed June 30, 2006, that Joss does not teach or suggest "a deforming element configured a resiliently-deformable surface, wherein said deforming element increases deformability of said resiliently-deformable surface," as recited in independent claim 1 (Page 2 of Remarks). This argument is not found persuasive. The examiner remains his position that Joss clearly teaches a deformable element (118, 120, which functions as a height tensile strength spring, acts to further dampen vibration, mechanical shocks etc. (col. 2, lines 61-62), which can increase or decrease a deformability of the resiliently-deformable surface as stated in the office action. Furthermore, the examiner submits that the metal is deformed under stress as broadly interpreted by definition; and the term "deformable" is also relatively broad that "virtually everything will deform or flex if enough pressure is applied to it". See *Fredman V. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969).

With respect to the argument that "spring 118 is not a portion of planar surface 104, but it is instead attached thereto via rivet 130" (page 2, para. 2). This is also not persuasive. The examiner considers spring 118 is a portion of planar surface 104 and is configured from a resiliently-deformable surface 104 as claimed. Nevertheless, arguing that spring 118 is not a portion of planar surface 104 is irrelevant, is based on what not claimed. In addition, the examiner also considers the spring 118 and planar surface 104 are structurally integral in functional sense since they are rigidly secured.

With respect to the argument that Joss et al. does not teach or suggest that "said fastening creates a thermal interface between said computer-mounted device and said sidewalls," as recited in dependent claim 21 (Page 2, paragraph 3). This is also not found persuasive. First, claim 21 recites the "wherein" clause of the subject matter should be positively set forth in the body of the claim. Currently, applicants are improperly using a "wherein" to purportedly define structure of the system. The "computer-mounted device" is drawn into the claim 21 while the "computer-mounted device" is not part of the claimed invention (see the preamble). Is the "computer-mounted device" a required part of the system or not? Applicant cannot relate the device to something not positively claimed, not defined and rely on that "not claimed", "not defined" to define over the art as part of the claim. In view of the above reasons, the examiner considers the claim uses a functional "wherein" clause that is failed to particular point out and distinctively claim the apparatus but only allude to the merit of purposes. Therefore, the examiner has not given much weight. Secondly, even Applicant is positively claimed the "computer-mounted device", the structure of Joss et

al. still met on the phrase "wherein, said fastening creates a thermal interface between said computer-mounted device and said sidewalls," as recited in dependent claim 21.

In this regard, the examiner's position is that the fastening of Joss et al which includes the mounting bracket and fastening receptacle can allow heat that moves or flows from one body to another, thus it inherently creates a thermal interface between said device and said sidewalls of the bracket. Note that as disclosed in Joss et al. that the pad 114 constructed from " a compliance elastomeric material or any composition with desired damping properties is a potential candidate" (col. 2, lines 50-53), which in this case is clearly compatible with a thermal interface material as claimed by Applicant (see claims 10-11, for example) (thermally-conductive elastomer sheet material).

Applicant's argument with respect to Ramsdell as pointed out on page 3, para. 3 is also not persuasive. Contrary to Appellant's argument, Ramsdell clearly teaches a pair of attachment members (20) (U-shaped) disposed on opposite sides of and attached to said surface and adapted to interface with the device (gun) upon deformation of said deforming element as recited in claim 1 as evidently shown on Fig. 2 or 3. Thus claim 1 is therefore fully met by Ramsdell.

With respect to the argument that Ramsdell does not teach or suggest "said fastening creates a thermal interface between said computer mounted device and said sidewalls," as recited in independent claim 21. This argument is similar to the argument on Joss et al., the examiner refers to the same argument as noted in the response above.

With respect to the argument that "Ramsdell is directed to a gun holder for vehicles and does not disclose a computer-mounted device therefore Ramsdell is insufficiently to meet every element of independent claim 21 under 35 U.S.C 102" (Page 3, para. 4). This is also not found persuasive. Appellant should note that anticipation by a reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed thereby. A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, explicitly or implicitly. Moreover, the law of anticipation does not require that the reference teach what is being claimed. Rather, the claims need only "reads on" the reference for anticipation to exist. Currently, the "system" as claimed "read on" Ramsdell and thus is not patentable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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PL PL 4/19/07
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Examiner
April 26, 2006

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